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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/177,047 10/22/98 BRINKLEY

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EXAMINER

JOHNSON, S

ART UNIT	PAPER NUMBER
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3641

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DATE MAILED:

11/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/177,047

Applicant(s)
Kenneth L. Brinkley

Examiner
Stephen M. Johnson

Art Unit
3641



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 19, 2001 and 8/13/2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29, 31-35, and 38-67 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 31-35, and 38-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19/2001; 8/13/2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 3641

1. The proposed drawing corrections filed on 4/19/2001 (with regard to figs. 1-4) have been disapproved. In reissue cases, amendments to the original drawings are not permitted. (see 37 CFR 1.121(b)(3)(I)).
2. The proposed additional fig. 5 filed on 4/19/2001 has been approved.
3. The proposed drawing corrections filed on 8/13/2001 (with regard to fig. 2) have been disapproved. In reissue cases, amendments to the original drawings are not permitted. (see 37 CFR 1.121(b)(3)(I)).
4. The proposed additional fig. 5 filed on 8/13/2001 has been approved.
5. The drawings are objected to because numerical indicator 30 (col. 5, line 18) and numerical indicator 7 (col. 6, line 49) are not illustrated. **Correction is required.**
6. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.
7. The disclosure is objected to because of the following informalities: On col. 6, line 48, numerical indicator 26 should be 28.

Appropriate correction is required.
8. Claims 1-13, 22-27, 31, 38, 40-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3641

The preamble of the claim is inconsistent with the body of the claim language. The preamble is directed to the subcombination (a firearm monitoring device) whereas the body of the claim is directed to the combination (a firearm monitoring device in combination with a firearm). This makes the claim language indefinite as to intended breadth. Applicant is required to clarify whether the claims are intended to be directed to the subcombination or the combination and to amend the claims consistent with the intent.

9. Applicant argues that each of the limitations found in the body of the claim are limitations directed entirely to the firearm monitoring device. The examiner does not agree. In claim 1, applicant claims "said inertia switch comprising a moveable mass resiliently biased in a direction substantially opposite said first direction"; and "an electrical circuit ... generate a second signal indicative of the number of said firearm discharges". In claim 22 and 63, applicant claims "said electrical circuit configured to ignore any signals generated by said inertia sensor within a predetermined time period following the generation of an initial one of a series of said first signals". In claim 27, applicant claims "an electrical circuit ... to determine that said firearm has been discharged based solely on receipt of said first signal and to generate a second signal indicative of the number of firearm discharges in response only to said first signal". In claims 42 and 55, applicant claims "said inertia sensor comprising a moveable mass resiliently biased in a direction substantially opposite said first direction".

These are all limitations directed to the monitoring device in combination with the firearm.

Art Unit: 3641

It should also be noted that in numerous sections of applicant's arguments, with regard to the applied prior art, applicant has argued that the reference lacks a claim feature that applicant is now arguing is not intended to be a portion of his invention. For instance, applicant argues that Horne et al. lacks "a moveable mass resiliently biased in a direction substantially opposite a first direction" (see page 15, lines 15-16 of the response filed on 4/19/2001 (paper #16)). Applicant further argues that Johnson (704) lacks "ignore any signals generated ... within a predetermined time..." (see page 9, lines 17-18 of the response filed on 4/19/2001 (paper #16)).

Applicant appears to be arguing claim features when it is desirable to read over the art and denying that the claims are intended to be drawn to the same claim features when attempting to overcome issues of indefinitcy.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-2, 4-6, 9, 12-15, 18, 21, 28, 32-33, 38-39, 42-43, 45-47, 50, 53-56, 59, 62, and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al..

Johnson et al. disclose a device for counting pulses comprising:

- | | |
|---------------------------|----------------------------|
| a) an inertia sensor, | 36, 38, or 50, 52 or
28 |
| b) an electrical circuit, | 12, 14, 32, 34 |

Art Unit: 3641

c) signal indicative of number of pulses, and 10

d) a cylindrical housing. see fig. 3

12. Applicant's arguments are addressed as follows. It is argued that items 36, 38, 50, and 52 do not meet the claim limitation directed to "inertia sensor". Webster's defines the term "sensor" as "a device that responds to a physical stimulus (as heat, light, sound, pressure, magnetism, or a particular motion) and transmits a resulting impulse". Clearly, each time reciprocating part 38 moves in and out of induction coil 40, a resulting impulse signal is transmitted (see col. 3, lines 1-5 and 10-17). With regard to the issue of the sensor sensing inertia, each time reciprocating part 38 moves to overcome the inertia of the bolt carrier, inertia is being sensed. With regard to the argument directed to element 28, Johnson et al. meets the claim limitation directed to "inertia sensor" without relying on this particular element. Further, it is difficult to understand how applicant's inertia switch assembly 4, 22, 24, 20 can be properly described as an inertia sensor but inertia switch 36, 38, 40 of Johnson et al. cannot.

It is further argued that there is nothing in Johnson et al. that indicates that the elements that deliver the force to the piezoelectric force transducer are inertia driven. In response, both the piezoelectric transducer 50 and the inertia switch assembly 36, 38, 40 are inertia driven. In the case of the inertia switch assembly, it is the movement of bolt carrier 38 against a recoil spring upon firing that is the inertia being counted or sensed each time the bolt carrier moves backward to overcome its own inertia as well as the force of the recoil spring. With regard to piezoelectric transducer 50, force 52 may be made by buffer impact (see col. 3, lines 13-14). Buffer impact is

Art Unit: 3641

associated with the movement of a recoiling element of the firearm each time the firearm is fired. Consequently, it is the impact of this recoiling element that is the inertia being sensed by piezoelectric transducer 50.

Applicant further argues that the examiner has ignored claim limitations directed to “a moveable mass resiliently biased in a direction substantially opposite said first direction”. In response, bolt carrier 38 meets the claim limitation directed to a moveable mass. The claim limitation directed to “resiliently biased in a direction substantially opposite said first direction” is met by the recoil spring associated with the bolt carrier. It should be noted that almost every bolt carrier in this art has a recoil spring acting to bias the bolt carrier in a direction opposite the firing direction. By way of example, see Sullivan (438), VanVoorhees (446), Weldle (530), Malhotra (898), and Kalb (678) to name only a few. Consequently, the examiner is relying upon the inherent understanding of anyone of knowledge in this art to meet the claim limitation directed to “resiliently biased in a direction substantially opposite said first direction”. With regard to the argument that resiliently biasing bolt carrier 38 would prevent operation of the device in the intended manner, this argument is not convincing. In fact, it is not understood as to how the Johnson et al. device could operate if the bolt carrier 38 were not resiliently biased in a direction opposite the direction of firing. First, the firearm itself would not be operational because the bolt carrier 38 could not be returned to its initial position to close the breech of the barrel and load the next round. Second, the bolt carrier 38, would not be in position to move once again through the

Art Unit: 3641

induction coil 40. This is necessary to count the second, third, and fourth round by counter 10 as is the intended design of the Johnson et al. device (see col. 2, lines 60-65).

13. Claims 28, 32-33, and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by Horne et al. (307).

Horne et al. (307) disclose a device for counting pulses comprising:

- | | |
|---|---------------------|
| a) an inertia sensor, | 28, 28b, 32, 34 |
| b) an electrical circuit, | 50 |
| c) signal indicative of number of pulses, and | 24 |
| d) disregard signals in predetermined time. | col. 5, lines 44-62 |

14. Applicant's arguments are addressed as follows. It is argued that items 28, 28b, 32, and 34 in combination do not constitute an inertia sensor or switch. First, item 34 is clearly a switch. See col. 4, line 52. It is also a sensor in that it switches after movement of the slide (an inertia member) and is in fact designed to sense movement of this slide member (see col. 4, lines 45-58). With regard to the claim limitation directed to "a moveable mass resiliently biased in a direction substantially opposite a first direction". Plunger 28 is biased in a rearward direction via spring 32. With regard to the plunger being biased in the direction of recoil, this is the case. Note that this direction is opposite the direction hinge 14f is moved when it overcomes its inertia.

15. Claims 1-29, 31-35, and 38-67 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter because the claim language is directed to subject matter surrendered in the original application by changes made to the claims in an effort to overcome a

Art Unit: 3641

prior art rejection and/or arguments made in an effort to overcome the prior art. (See Clement 131 F.3d at 1469, 45 USPQ2d at 1164).

This is in regard to the claim language added by amendment filed on 2/20/96 as follows:
“for attaching to a firearm, said firearm having a firing end and a grip end, and”; and
“wherein said first means comprise an inertia switch comprising a movable mass; and wherein said mass is resiliently biased toward the firing end of the firearm”.

This is also in regard to the arguments filed on 2/20/96 directed to “the movable mass is resiliently biased toward the firing end of the firearm”.

16. Applicant's arguments are addressed as follows. Applicant refers to MPEP 1412.01 and that the mere failure to claim a disclosed embodiment in the original patent would not be grounds to prohibit claiming that embodiment in the reissue. In response, it should be noted that the examiner is not prohibiting applicant from claiming another embodiment based upon a failure to claim the disclosed embodiment. Rather, Reissue practice is directed to not permitting applicant from claim subject matter that he has surrendered in an application to obtain the original patent (Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); In re Wadlinger, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); In re Richman, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); In re Willingham, 282 F.2d 353, 127 USPQ 211 (CCPA 1960)).

Art Unit: 3641

All that MPEP 1412.01 states is that “the mere failure to claim a disclosed embodiment” would not be grounds to prohibit claiming. It does not state that there would not be some other grounds to prohibit claiming. In this case, the other grounds would be improper recapture.

It is further argued that the Federal circuit has held that claims which are narrower in all aspects than the claims that constitute the surrendered subject matter are not barred by the recapture rule. Clearly this argument does not apply to the current situation. If the claims were narrower in all respects than the surrendered subject matter, all claimed subject matter and in particular the claimed subject matter at issue (see paragraph 15 above) would be included in the claims. This is not the case with regard to claims 1-29, 31-35, and 38-67; the claims at issue.

Applicant argues that “when reissue claims are broadened in respects related to surrendered subject matter, the claims may avoid the recapture rule if the claims “were materially narrowed in other respects”” and that “deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicated the contrary”.

With regard to the first argument, it should be noted that the language used by the court is “the claims **may** avoid the recapture rule”. The examiner is not convinced that this is a situation where the recapture should be avoided and in particular makes note of to the second step of determining if recapture is present. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made

Art Unit: 3641

in an effort to overcome a prior art rejection (See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984)).

With regard to the second argument, note the phrase “but is not dispositive because other evidence in the prosecution history **may indicated the contrary**”. The examiner can find no evidence of a contradiction in the prosecution history. The prosecution history indicates that applicant both amended his claims and argued with respects to his claims in the amendment filed on 2/20/96. The case subsequently issues in response to these amendments and arguments. Consequently, the prosecution history is not contradictory but is consistent dependent upon what applicant chose to claim at each stage of the prosecution.

Applicant concludes that it is not the amended claim that represents surrendered claimed subject matter, but rather the second to last amendment. The examiner can find no support for this conclusion and in fact this conclusion seems contrary to the accepted application of the law. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims **made in an effort to overcome a prior art rejection** (See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984)). Further, it is not understood as to what is meant by the argued second to last amendment. The claims in Serial Number 08/177,047 were rejected on 10/10/95 (paper #3) on art and 35 USC 112 issues. The claims were amended as well as argued on 2/20/96 (paper #4). Papers #5 and #6 are directed to extensions of

Art Unit: 3641

time and associate power of attorney. A notice of allowability was mailed on 4/12/96 in response to paper #4. Consequently, the only paper directed to the applied art and 112 issues is paper #3, filed on 2/20/96, and this is what is being relied upon in the recapture issue.

It is further argued that “the claims must be rejected and amended again” for recapture to apply. The examiner see nothing in the argued court decisions to support such a conclusion.

With regard to the argument that Hester supports the conclusion that “arguments can surrender subject matter added by that amendment”, this argument seems consistent with the recapture rule as presently applied in this case.

Applicant argues that the examiner in applying prior art rejections, under 35 USC 102 and 103, that were based upon an incorrect interpretation of the means plus function limitations in claims 1 and 12 (as prosecuted). In response, this argument is not addressed to a “contradiction in the prosecution history” as is required to apply the appropriate case law but rather is directed to a prior art rejection that applicant has now decided to argue. Consequently, this argument is not convincing.

Applicant argues that the amendments to claims specifically relied upon amendments to the preambles of original claims 1 and 12 (of 08/376,047). This is not convincing and is in factually incorrect. The amendments to claim 1 are directed to the preamble as well as the body of the claim. The amendments to claim 12 are directed entirely to the body of the claim. Consequently, all arguments directed to the scope of the claims being unaffected by applicant’s amendments are not convincing. With regard to applicant’s argument that none of the changes or

Art Unit: 3641

amendments that were made to original claims 1 and 12 were made to avoid prior art because the amendments were directed to the preamble of the claim, this argument is not factually correct and is therefor not convincing.

With regard to the arguments and claim comparisons of claims 1 and 12. The examiner will compare claim 12 (of 08/376,047) to the claims at issue in view of the fact that it is so similar to claim 1 (of 08/376,047). Claim 12 claims "said firearm having a firing end and a grip end". None of the features argued on page 25 of applicant's comparison of claims contains this feature. If the claims don't contain this feature, they are broader in scope than claims 1 and 12 with regard to this claim feature. Claim 12 claims "wherein said first means comprise an inertia switch comprising a movable mass; and wherein said mass is resiliently biased toward the firing end of the firearm". None of the claim features argued on page 25 of applicant's response contain this claim feature. The closest claim feature is directed to "said inertia switch or sensor comprising a moveable mass resiliently biased in a direction substantially opposite said first direction". (1) A sensor is not the same as a switch and is not equal in scope to such terminology. The term "sensor" is directed to numerous different devices that can sense inertia changes. The term "switch" is a particular type of device that senses changes in inertia. (2) "Resiliently biased in a direction opposite the first direction" while similar to "resiliently biased toward the firing end of the firearm" is not the same as the firing end and is therefor not equal in scope to such terminology. For the above reasons, each of these claim limitations are narrower in scope (in some respect) than what applicant is proposing to claim in his current reissue claims.

Art Unit: 3641

With regard to the argument that MPEP 1412.01 permits applicants to claim embodiments even if they violate the recapture, see the above response directed to this portion of the MPEP.

With regard to the argument that claim 29 is materially narrower than the scope of the claims originally surrendered (claims 1 and 12 of 08/376,047), this is not entirely correct. Claim 29 is narrower to claims 1 and 12 in some respects and broader in other respects. It is this portion that is broader (i.e. fails to include the claim limitations previously relied upon for issuance of the case) that makes the recapture rule applicable in this case. The recapture rule applies to claims 28 and 67 for the same reasons it applies to claim 29.

17. Applicant's arguments filed 4/19/2001 and 8/13/2001 have been fully considered but they are not persuasive. These arguments have been addressed in the preceding paragraphs of this Office action.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sullivan (438), VanVoorhees (446), Weldle (530), Malhotra (898), and Kalb (678) disclose state of the art breech block carriers with associated return spring assemblies. Webster's definition (page 1072) with regard to the term "sensor" is also included.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

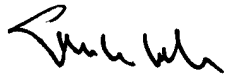
Art Unit: 3641

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is (703)-306-4158. The examiner can normally be reached on Tuesday-Friday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703)-306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703)-305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-306-4177.



STEPHEN M. JOHNSON
PRIMARY EXAMINER